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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,484	05/24/2006	Bradley R. Hammell	F-759-P1	2385

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PITNEY BOWES INC.  
35 WATERVIEW DRIVE  
MSC 26-22  
SHELTON, CT 06484-3000

EXAMINER
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IWARERE, OLUSEYE

ART UNIT	PAPER NUMBER
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3687

NOTIFICATION DATE	DELIVERY MODE
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05/11/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

iptl@pb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/580,484	<b>Applicant(s)</b> HAMMELL, BRADLEY R.	
	<b>Examiner</b> OLUSEYE IWARERE	<b>Art Unit</b> 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) 6-12 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 13-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This communication is a First Office Action Non-Final rejection on the merits. Claims 1 – 5 and 13 – 17 as originally filed are currently pending and have been considered below.

### ***Election/Restrictions***

2. Applicant's election with traverse of Group I in the reply filed on 4/09/2009 is acknowledged. The traversal is on the ground(s) that both groups defined by the Examiner relate to providing status of a shipment being transported by a carrier, they appear to be linked as a single general inventive concept. This is not found persuasive because the two groups recite distinct method steps in the same statutory category.

The requirement is still deemed proper and is therefore made FINAL.

Correction: Group I should be claims 1 - 5 and 13 - 17. Group II should be Claims 6 - 12 and 17 - 20. Claims 17 - 20 belong in Group II because they depend on independent claim 6 which is a member of Group II.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1 – 5 and 13 – 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Lau (7,212,829).**

**As per claims 1 and 13,** Lau discloses a system and method for a user to find pinpoint status of a shipment being transported by a carder, comprising the steps of:

clicking on a shipment pinpoint symbol on a computer screen (col. 5, lines 53 – 62 discuss user selecting);

connecting automatically to an internet or private network, if a connection is not already established (col. 4, lines 37 - 50 discuss connecting to the internet);

sending automatically a shipping pinpoint inquiry to the carder via the internet or private network (col. 4, lines 55 – 67 discuss a tracking the location information of the shipment);

requesting a pinpoint location of the shipment in response to the shipping status inquiry (col. 4, lines 55 – 67 discuss a tracking the location information of the shipment); and

receiving the requested pinpoint location of the shipment to the computer screen, wherein the pinpoint location identifies a position between checkpoints at each of which shipment presence is monitored regardless of user inquiries (col. 4, lines 55 – 67 discuss a tracking the location information of the shipment).

**As per claims 2 and 14**, Lau discloses wherein the shipment pinpoint symbol is an icon of a file, in a markup language, including a tracking code of the shipment (fig. 6 depicts icons).

**As per claims 3 and 15**, Lau discloses wherein the shipment pinpoint symbol is provided to the computer screen in conjunction with a shipment checkpoint symbol (fig. 6 depict pinpoint symbols), and

wherein the shipment checkpoint symbol is for obtaining information as to the presence of at least one of the checkpoints (fig. 6 depicts position information).

**As per claim 4**, Lau discloses wherein if the step of providing the pinpoint shipping status information to the computer screen is performed later than a certain time after the step of sending automatically the shipping pinpoint inquiry, due to a delay, then a user of the computer screen is compensated for the delay (see "Conditional limitations" paragraph below).

**As per claims 5 and 16**, Lau discloses wherein the position is separate from all of the checkpoints (abstract discusses positions of the item shipped).

**As per claim 17**, Lau discloses further comprising:  
determining if the position indicates arrival at a delivery checkpoint (col. 5, line 63 - col. 6, line 10 discusses determining arrival); and

if the position indicates arrival at the delivery checkpoint, modifying the file; in a markup language, to remove the tracking code of the shipment (see "conditional limitations" paragraph below).

### ***Conditional Limitations***

5. The Examiner notes in claim 1, connecting automatically to an internet or private network is dependent on the phrase "if a connection is not already established ..." This phrase is a conditional limitation.

The Examiner notes in claim 4, a user of the computer screen is compensated for the delay is dependent on the phrase "if the step of providing the pinpoint shipping status information to the computer screen is performed later than a certain time after the step of sending automatically the shipping pinpoint inquiry ..." This phrase is a conditional limitation.

The Examiner notes in claim 17, modifying the file is dependent on the phrase "if the position indicates arrival at the delivery checkpoint ..." This phrase is a conditional limitation.

The noted steps are not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios. [See: *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C].

Furthermore, the "if" steps of claims 1, 4 and 17 are conditional limitations and are given little patentable weight. Methods are composed of actions, when you perform the actions of a method and do not select one of the alternatives or "if" steps, you are not performing any action under those alternatives.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sandell (US 7191142 B1), Riggs (US 20080040144 A1) and Hancock (US 20080183526 A1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUSEYE IWARERE whose telephone number is (571)270-5112. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on (571)272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/O.I./

Patent Examiner, AU 3687

/Matthew S Gart/

Supervisory Patent Examiner, Art Unit 3687